

REMARKS

In the Office Action mailed November 12, 2009 (hereinafter "Office Action"), Claims 35 and 41 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Claim 44 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claims 37, 39-41, and 43 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,036,601, to Heckel (hereinafter "Heckel"). Claims 26-30, 33-35, and 42 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Heckel, and alternatively over Heckel in view of U.S. Patent No. 6,196,920, to Spaur (hereinafter "Spaur"). Claim 31 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Heckel in view of U.S. Patent Publication No. 2002/0156858, by Hunter (hereinafter "Hunter"), and alternatively over Heckel in view of Spaur and Hunter. Claim 36 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Heckel in view of Spaur. Applicants respectfully disagree with these rejections, but have nevertheless amended the claims to further advance prosecution of the present application.

With this response, Claims 26-31, 34-37, 39, 40, 42, and 43 have been amended. Claims 41 and 44 have been canceled. Accordingly, Claims 26-31, 33-37, 39, 40, 42, and 43 remain pending in the present application. Applicants have carefully considered the issues raised in the Office Action, and respectfully request reconsideration and allowance in view of the remarks set forth below.

Claim 35 is Described in the Specification

The Office Action rejected Claim 35 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, the Office Action alleges that "thresholds that are greater than zero" with regard to a time and a screen size that cause a hit count to be incremented are not supported by the specification. Applicants respectfully traverse this rejection.

Applicants respectfully point out that there is no *in haec verba* requirement, and that newly added claim features can be supported in the specification through express, implicit, or inherent disclosure. M.P.E.P. § 2163. The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicants were in possession of the invention as now claimed. *Vas-Cath v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991); M.P.E.P. § 2163.

Applicants respectfully submit that "incrementing the hit count in response to determining that the time or screen size meet thresholds that are greater than zero," as recited in Claim 35, is disclosed in the specification with reasonable clarity to those skilled in the art, so as to comply with the written description requirement. For example, the specification at page 23, lines 10-14, discloses the following:

Another way to reflect the exposure of the advertisements displayed in the game would be to set a minimum time and screen size to qualify as an ad "hit." For example, each time an advertisement takes up 3% of the users video screen for 3 seconds it would be classified as a 'hit', then the number of hits per game could be counted and sent to the ad server in the event logging step 211.

Applicants respectfully submit that the disclosure of "a minimum time and screen size" in this passage conveys to one of skill in the art that a threshold greater than zero is in use. Indeed, at least two examples of thresholds that are greater than zero — "3% of the users video screen" and "3 seconds" — are disclosed in the above-quoted passage. Hence, an interpretation of "a minimum time and screen size" as disclosing only a threshold that is equal to zero would be beyond reason.

Accordingly, applicants respectfully submit that the features of Claim 35 is disclosed in the application as filed, and that the Section 112, first paragraph, rejection was made in error. Applicants further submit that the similar rejection of Claim 41 was similarly made in error, but

since Claim 41 has been canceled, the rejection has been rendered moot. Applicants respectfully request withdrawal of these rejections.

The Rejection of Claim 44 Has Been Rendered Moot

The Office Action rejected Claim 44 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicants respectfully disagree with this rejection, but have nevertheless canceled Claim 44 to further advance prosecution of the present application.

Applicants submit that the Section 112 rejection of Claim 44 has been rendered moot, and respectfully request withdrawal of the rejection.

Claims 26-31, 33-37, 39, 40, 42, and 43 Are Patentable Over Heckel, Spaur, and Hunter

Independent Claim 26

The Office Action rejected Claim 26 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Heckel, and alternatively as allegedly being unpatentable over Heckel in view of Spaur. Applicants respectfully disagree with this rejection, but have nevertheless amended Claim 26 to further advance prosecution of the present application.

As amended, Claim 26 recites:

26. A computer-based method for dynamically incorporating advertisements into a video game defined by gaming code that is executing on a game client system, comprising:

establishing a network connection to a game server;

establishing a dribble pipe connection to an advertising server separate from the game server, wherein the dribble pipe connection continuously carries data packets from the advertising server to the game client system while the dribble pipe connection is maintained, and wherein a predetermined, fixed amount of time elapses between consecutive data packets carried by the dribble pipe connection; and

while the gaming code is executing and the game is being played:

receiving in the data packets of the dribble pipe connection and storing on the game client system at least one advertisement, the advertisement having a content and at least one advertisement attribute;

detecting an advertising tag associated with a game object that is presented to a game player, wherein the advertising tag defines criteria for an advertisement to be associated with the game object;

determining, by the game client system, whether an advertisement attribute of a stored advertisement matches one or more criteria defined by the detected advertising tag, and in response to determining that an advertisement attribute of a stored advertisement matches one or more criteria defined by the advertising tag, inserting the content of the matching advertisement into the video game by presenting the content as part of the game object; and

maintaining the dribble pipe connection during a remaining duration of time the gaming code is executing and the game is being played, including receiving at least one additional advertisement in the data packets of the dribble pipe connection.

Applicants respectfully submit that Heckel and Spaur, both alone and in combination, fail to disclose or suggest the combination of features recited in amended Claim 26, including "establishing a dribble pipe connection to an advertising server" that "continuously carries data packets from the advertising server to the game client system while the dribble pipe connection is maintained, and wherein a predetermined, fixed amount of time elapses between consecutive data packets carried by the dribble pipe connection," and "maintaining the dribble pipe connection during a remaining duration of time the gaming code is executing and the game is being played."

Heckel purportedly discloses a method for advertising within games played over a network. (Heckel, Col. 1, lines 7-8.) Heckel purportedly describes an ad server which "presents . . . ad textures 15 to the user's computer 11 for download into a local texture store 14." (Heckel, Col. 4, lines 49-53.) Heckel states, "Once all of the ad textures 15 are loaded and ready, and the user 1 and the game server 20 are ready, play will commence." (Heckel, Col. 4, lines 59-61.) Later, Heckel states, "Between each level of play, while the game is waiting to synchronize with the game server 20, additional advertising textures 15 and information may be exchanged between the ad server 26 and the user computer 11[.]" (Heckel, Col. 5, lines 16-20.)

The Office Action points to no other portions of Heckel that further describe the transmission of ad textures from the ad server to the user's computer.

Nothing in Heckel discloses or suggests that the connection between the ad server and the user's computer is a "dribble pipe connection," as recited in amended Claim 26. The dribble pipe connection of Claim 26 "continuously carries data packets from the advertising server to the game client system while the dribble pipe is maintained," and the dribble pipe is maintained "during a remaining duration of time the gaming code is executing and the game is being played." Further, "a predetermined, fixed amount of time elapses between consecutive data packets carried on the dribble pipe connection."

Even if, as alleged by the Office Action, Heckel recurringly sends ad textures to the user's computer — first, before "play will commence," and then later "between each level of play" — this recurrence does not disclose or suggest a connection that "continuously carries data packets" with "a predetermined, fixed amount of time elaps[ing] between consecutive data packets." Indeed, since the ad textures are not sent to the user's computer during each level of play, but instead before "play will commence" and later "between each level of play," Heckel forecloses the possibility of "a predetermined, fixed amount of time elaps[ing] between consecutive data packets."

Spaur is cited by the Office Action as allegedly teaching "requesting such advertising content for display while the user is playing the game." (Office Action, page 10.) Applicants respectfully submit that neither this alleged teaching, nor anything else in Spaur, makes up for the deficiencies discussed above in Heckel, and Spaur similarly fails to disclose or suggest the recited "dribble pipe connection" of amended Claim 26.

As discussed in the previous response, Spaur discloses that "[w]hen the ad server 60-n is notified of a new player, it sends out the advertising information to the new client machine[.]" (Spaur, Col. 10, lines 4-7.) Spaur also states that this advertising information "should fit in one packet for most client machines 30." (Spaur, Col. 10, lines 9-11.) Spaur further discloses that

"[w]hen the ad server 60-n updates its ads from the database server 70, . . . each client machine 30-1n through 30-nn is notified of the new ads," and that a "load spike" occurs. (Spaur, Col. 10, lines 45-50.) Hence, Spaur fails to disclose or suggest a "dribble pipe connection" wherein "a predetermined, fixed amount of time elapses between consecutive data packets" that are "continually carrie[d] . . . from the advertising server to the game client system," or maintaining such a connection "during a remaining duration of time the gaming code is executing and the game is being played," at least because the advertising information is sent in a manner in which a load spike occurs.

Accordingly, applicants respectfully submit that Heckel and Spaur, whether considered separately or in combination, do not support a Section 103 rejection of Claim 26. Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections and allowance of Claim 26.

Dependent Claims 27-31 and 33-36

Claims 27-31 and 33-36 depend from Claim 26. Applicants respectfully submit that the foregoing comments and revisions to Claim 26, as discussed above, apply equally to Claims 27-31 and 33-36. In addition, Claims 27-31 and 33-36 recite additional claim features not shown or suggested by Heckel and Spaur.

For example, applicants respectfully submit that the cited patents and publications fail to disclose or suggest the combination of features recited in Claim 35, including incrementing a hit count if the time or screen size meet "thresholds that are greater than zero." The Office Action alleges that Heckel teaches "receiving quality data from the user system regarding time the advertisement is displayed (duration), the type of views (manner), the number of times displayed, and the size in terms of pixels," citing Column 5, lines 10-15 of Heckel. The cited portion of Heckel states, "These include the time each ad texture 15 is displayed, the number of ad textures 15 displayed, the size, in terms of pixels, each ad texture 15 occupies, and the type of views that the ad texture 15 is shown as." Applicants respectfully submit that nothing in this

passage teaches "the number of times displayed," as alleged by the Office Action. At best, the passage teaches "the number of ad textures 15 displayed," which is not "the number of times displayed." Further, the Office Action states that the "number of times displayed" is incremented "every time the size or time of an ad meets any threshold greater than '0'," but provides no support from Heckel for a number being "incremented" based on the collected statistics, let alone "every time the size or time of an ad meets any threshold greater than '0'." Accordingly, applicants respectfully submit that Heckel and Spaur, whether considered separately or in combination, do not establish a *prima facie* case that Claim 35 is obvious under 35 U.S.C. § 103.

As another example, applicants respectfully submit that the cited patents and publications fail to disclose or suggest the combination of features recited in amended Claim 36, including "modifying an interactive game behavior of a game object to behave differently during a subsequent interaction." Claim 36 has been amended to clarify the recited subject matter. While the Office Action alleges that moving a card to a different area of the screen discloses the features of Claim 36, applicants respectfully disagree. The position of the card on the screen is not an "interactive game behavior," and even if it were, nothing in Spaur discloses or suggests that such a behavior is modified "to behave differently during a subsequent interaction."

Accordingly, applicants respectfully request withdrawal of the rejections and allowance of Claims 27-31 and 33-36.

Independent Claim 37

The Office Action rejected Claim 37 under 35 U.S.C. § 102(e) as allegedly being anticipated by Heckel. Applicants respectfully disagree with this rejection, but have nevertheless amended Claim 37 to further advance prosecution of the present application.

As amended, Claim 37 recites:

37. A computer-based method for operating an ad server that delivers advertisements to a game client system, the advertisements having

respective content and respective advertisement specifications, the method comprising:

under the control of instructions executed by the ad server:

establishing a communication link with the game client system that is running a video game;

continually transmitting and receiving data packets over the communication link with a predetermined interval of time between pairs of transmitted data packets and between pairs of received data packets, including:

receiving from the game client system data packets including a request for an advertisement, the request defining one or more targeted criteria;

retrieving at least one advertisement having an advertisement specification that matches the one or more targeted criteria; and

transmitting data packets including the at least one retrieved advertisement to the game client system as part of the continually transmitted data packets; and

continuing to transmit and receive data packets over the communication link with a predetermined interval between pairs of packets until the game client system stops running the video game.

Applicants respectfully submit that Heckel fails to disclose each and every feature recited in independent Claim 37, including "continually transmitting and receiving data packets over the communication link with a predetermined interval of time between pairs of transmitted data packets and between pairs of received data packets," and "continuing to transmit and receive data packets over the communication link with a predetermined interval between pairs of packets until the game client system stops running the video game."

Similar to the discussion above with respect to Claim 26, applicants respectfully submit that nothing in Heckel discloses or suggests this type of communication link. Even if Heckel sends ad textures to the user's computer before "play will commence" and then later "between each level of play," nothing in Heckel discloses or suggests that this information is sent over a communication link that is "continually transmitting and receiving data packets" with "a predetermined interval of time between pairs of transmitted data packets and between pairs of

received data packets." Instead, Heckel merely discloses separate instances of transmitting ad textures.

Therefore, applicants respectfully submit that Heckel fails to anticipate Claim 37, for reasons similar to those discussed above with respect to why Heckel fails to disclose or suggest the features recited in Claim 26, as well as for other reasons. Accordingly, applicants respectfully request withdrawal of the 35 U.S.C. § 102(e) rejection and allowance of Claim 37.

Dependent Claims 39 and 40

Claims 39 and 40 depend from Claim 37. Applicants respectfully submit that the foregoing comments and revisions to Claim 37, as discussed above, apply equally to Claims 39 and 40. In addition, Claims 39 and 40 recite additional claim features not shown or suggested by Heckel or Spaur.

Accordingly, applicants respectfully request withdrawal of the rejections and allowance of Claims 39 and 40.

Independent Claim 42

The Office Action rejected Claim 42 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Heckel, and alternatively as allegedly being unpatentable over Heckel in view of Spaur. Applicants respectfully disagree with this rejection, but have nevertheless amended Claim 42 to further advance prosecution of the present application.

As amended, Claim 42 recites:

42. A computer-readable storage medium having stored thereon instructions that, in response to execution by a processor in a game client system, cause the game client system to execute operations for dynamically incorporating advertisements into a video game defined by gaming code, the operations comprising:

forming a communication link with a game server;
forming a communication link with an advertising server;

while the gaming code is executing and the video game is being played:

continually receiving data packets over the communication link with the advertising server such that a constant portion of bandwidth available to the game client system is used by the communication link with the advertising server, wherein a fixed period of time elapses between receiving the data packets;

receiving in the continually received data packets and storing on the game client system at least one advertisement, the advertisement having a content and at least one advertisement specification;

detecting an advertising tag associated with a game object that is presented to a game player, wherein the advertising tag defines criteria for an advertisement to be associated with a game object;

determining whether an advertisement specification of one of the received advertisements matches one or more criteria defined by the detected advertising tag, and in response to determining that an advertisement specification of a stored advertisement matches one or more criteria defined by the advertising tag, inserting the content of the matching advertisement into the game by presenting the content as part of the game object; and

continuing to receive data packets over the communication link with the advertising server until the gaming code is no longer executing and the video game is no longer being played.

Applicants respectfully submit that Heckel and Spaur, both alone and in combination, fail to disclose or suggest the combination of features recited in amended Claim 42, including "continually receiving data packets over the communication link with the advertising server such that a constant portion of bandwidth available to the game client system is used by the communication link with the advertising server, wherein a fixed period of time elapses between receiving each data packet," and "continuing to receive data packets over the communication link with the advertising server until the gaming code is no longer executing and the video game is no longer being played."

Similar to the discussion above with respect to Claim 26, applicants respectfully submit that Heckel fails to disclose or suggest these features. Nothing in Heckel discloses or suggests reserving "a constant portion of bandwidth available to the game client system" by "continually

receiving data packets," wherein "a fixed period of time elapses between receiving each data packet," and then receiving in such packets "at least one advertisement." At best, Heckel discloses transmitting ad textures before "play will commence" and "between each level of play," and not over a connection as recited in amended Claim 42. Applicants also submit that Spaur fails to make up for these deficiencies in Heckel, at least because Spaur transmits advertising information in a manner that causes "load spikes," and not in a manner that includes reserving "a constant portion of bandwidth available to the game client system," as recited in amended Claim 42.

Accordingly, applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections and allowance of Claim 42.

Independent Claim 43

The Office Action rejected Claim 43 under 35 U.S.C. § 102(e) as allegedly anticipated by Heckel. Applicants respectfully disagree with this rejection, but have nevertheless amended Claim 43 to further advance prosecution of the present application.

As amended, Claim 43 recites:

43. A computer-readable storage medium having stored thereon instructions that, in response to execution by a processor in an advertising server, cause the advertising server to execute a method for operating the ad server to deliver advertisements to a game client system, the advertisements having respective content and respective advertisement specifications, the method comprising:

establishing a communication link with the game client system that is running a video game;

continually sending and receiving a plurality of data packets to and from the game client system over the communication link at a constant rate;

receiving from the game client system a request for an advertisement within the continually received plurality of data packets, the request defining one or more targeted criteria;

retrieving at least one advertisement having an advertisement specification that matches the one or more of the targeted criteria;

transmitting the at least one retrieved advertisement within the continually sent plurality of data packets; and continuing to send and receive data packets over the communication link at the constant rate until the game client system stops running the video game.

Applicants respectfully submit that Heckel fails to disclose each and every feature recited in amended Claim 43, including "continually sending and receiving a plurality of data packets to and from the game client system over the communication link at a constant rate;" and "continuing to send and receive data packets over the communication link at the constant rate until the game client system stops running the video game."

Similar to the discussion above with respect to Claims 26 and 37, applicants respectfully submit that Heckel fails to disclose these features, at least because Heckel merely describes the transfer of ad textures to the user's computer before "play will commence" and "between each level of play." Nothing in Heckel discloses or suggests "continually sending and receiving a plurality of data packets to and from the game client system over the communication link at a constant rate," and then receiving a request and transmitting an advertisement over such a communication link, because Heckel merely discloses these two discrete instances of sending ad textures.

Accordingly, applicants respectfully request withdrawal of the 35 U.S.C. § 102(e) rejection and allowance of Claim 43.

CONCLUSION

In view of the foregoing amendments and remarks, applicants respectfully submit that the cited art does not support rejections of Claims 26-31, 33-37, 39, 40, 42, and 43, whether considered under 35 U.S.C. § 102 or § 103. Accordingly, applicants respectfully request reconsideration and allowance of the same. The Examiner is invited to contact the undersigned

attorney at the number provided below to resolve any issues that may arise in order to advance prosecution of this application.

Respectfully submitted,

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